

REMARKS

The Office is requiring restriction of the above-identified application as follows:

Group I: Claims 1-7, drawn to a composition;

Group II: Claim 8, drawn to a method of making the composition;

Group III: Claim 9, drawn to a method of coating; and

Group IV: Claims 10-11, drawn to an article.

Applicants have elected Group III, claim 9, with traverse.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples, to support any conclusion in regard to patentable distinctness (M.P.E.P. § 803). Applicants respectfully traverse the restriction requirement on the grounds that the Examiner has not carried the burden of providing sufficient reason and/or examples to support any conclusion that the claims of the restricted groups are patentably distinct.

The Examiner has categorized the relationships between Groups I and III as product and process of use. Patentable distinctness may be shown if either or both of the following can be shown: (A) that the process of using the product as claimed can be practiced with another materially different product or (B) that the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). The Examiner asserts that the composition or product as claimed can be used in a materially different process, such as a gaseous coating process.

However, the Examiner's assertion does not meet the requirements under § 806.05(h), because a mere generalization concerning the use of a different process is not evidence that the claimed composition/product can be used in a materially different process. Therefore, the

Examiner's reasoning is merely a restatement of the Examiner's conclusion that the two groups are patentably distinct, which is believed to be improper.

The Examiner has categorized the relationships between Groups II and I and Groups III and IV as a process of making and product made. Patentable distinctness may be shown if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). Regarding Groups II and I, the Examiner asserts that the claimed composition/product can be made by a materially different process, such as one in which the reaction does not take place in the presence of solvent. Regarding Groups III and IV, the Examiner asserts that the claimed article/product can be made by a materially different process, such as one in which the coating is applied by CVD.

The Examiner, however, does not meet the requirements of M.P.E.P. § 806.05(f), because her assertion is not evidence that the claimed article can be made by a process a process involving the application of the coating by CVD. Contrary to the Examiner's assertion, as discussed in the present specification, at page 2, lines 10-13, the present inventors have found that "tantalum oxide films formed by conventional **CVD** contain impurities and lattice defects caused by raw materials and film forming methods, which cause a leak current and deteriorate dielectric strength" (emphasis added). As such, the claimed invention, which solves such problems, cannot be produced by such a process.

Moreover, the Examiner has not shown or provided evidence that merely excluding solvent from the claimed process would be another and materially different process or even that the claimed composition can be produced from such an exclusion. Therefore, Examiner's reasoning is merely a restatement of the Examiner's conclusion that the groups are patentably distinct, which is believed to be improper.

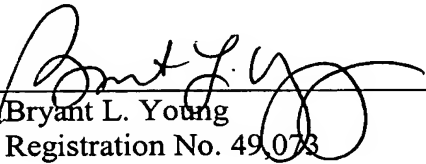
Application No. 10/820,056
Reply to Office Action of August 12, 2005

Accordingly, for at least the reasons presented above, Applicants submit that the Examiner has failed to meet the burden necessary to sustain the restriction requirement. Withdrawal of the requirement is respectfully requested.

Applicant submits this application is now in condition for examination on the merits and early notification of such action is earnestly solicited.

Respectfully submitted,

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